

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596736; Comm-G

CASE PARTICULARS**APPLICANT INFORMATION**

Name of Applicant: Robert Victor Marcon
Mailing Address: Street: 3471 Sinnicks Avenue
City/Province: Niagara Falls, Ontario
Country: Canada
Zip Code: L2J 2G6
Other Communications: Telephone: (905) 354-2543

OPPOSER'S INFORMATION

First Opposer: L'Oreal USA, Inc.
Mailing Address: 575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications: Unknown

Second Opposer: L'Oreal S.A.
Mailing Address: L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications: Unknown

Opposer's Attorney: Robert L. Sherman,
Paul, Hastings, Janofsky & Walker LLP
Mailing Address: Street: 75 East 55th Street
City/State: New York, New York
Country: U.S.A.
Zip Code: 10022
Other Communications: Telephone: (212) 318-6000
e-mail: rls@paulhastings.com



12-03-2009

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"

COMMUNICATION - G
REQUEST FOR FURTHER INFORMATION

This is a response to the two Office Letters that were mailed November 10, 2009 by the Trademark Trial and Appeal Board to the Applicant herein, namely, Robert Victor Marcon (copies of both letters enclosed). Both Office Letters consist of a "Notice of Abandonment" regarding the Applicant's current application (Serial No. 76/596,736). The "Notice of Abandonment" was issued because the Board had not received a response from the Applicant to the Board's "Notice of Default" that was sent to the Applicant on September 30, 2009.

Unfortunately, the Applicant believes that a mistake has been made. That is because the Applicant had sent a response to the Board's "Notice of Default". That response was sent via U.S. Certified First Class Mail (serial No. 7008 3230 0000 5106 2881) on October 28, 2009. That response was also received by the Board on October 30, 2009 which was within the 30 day time frame allotted by the Board for a response.

Proof of this claim is provide by the Applicant in the return receipt postcard that was stamped by the USPTO on October 30, 2009 and sent back to the Applicant (copy enclosed).

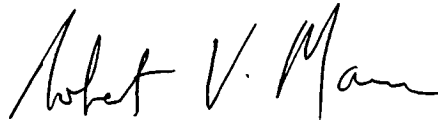
Consequently, the Applicant has therefore enclosed a copy of the original "Communication-F" that was sent to the Board on October 28, 2009 and received October 30, 2009 in case the first one has been lost.

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596736; Comm-G

If the Applicant's perceptions are correct the Applicant believes that his application should be reinstated and the current opposition proceedings restarted.

The Applicant looks forward to the Board's response in this matter.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert V. Marcon". The signature is fluid and cursive, with the first name "Robert" and last name "Marcon" clearly distinguishable, and a middle initial "V." in between.

Robert V. Marcon,
Applicant Pro Se
December 1, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

AM

Mailed: November 10, 2009

Opposition No. 91184456

L'Oreal USA, Inc.

v.

Marcon, Robert Victor

On September 30, 2009, the Board sent a notice of default to applicant because no answer to the amended notice of opposition had been filed.

The record shows no response thereto.

Accordingly, judgment by default is hereby entered against applicant, the opposition is sustained, and registration to applicant is refused. See Fed. R. Civ. P. 55, and Trademark Rule 2.106(a).

*By the Trademark Trial
and Appeal Board*



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Nov 10, 2009

NOTICE OF ABANDONMENT

ROBERT V. MARCON

TM115

ATTORNEY
REFERENCE
NUMBER:

3471 SINNICKS AVENUE
NIAGARA FALLS, ON L2J 2G CANADA

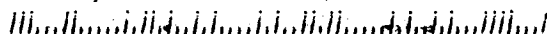
SERIAL NUMBER: 76/596736
MARK: L'OREAL PARIS
APPLICANT: Marcon, Robert Victor

THE ABOVE IDENTIFIED TRADEMARK APPLICATION WAS ABANDONED
ON 11/10/2009 FOR THE FOLLOWING REASON:

AS A RESULT OF THE TRADEMARK TRIAL AND APPEAL BOARD
PROCEEDINGS, THE ABOVE IDENTIFIED APPLICATION STANDS
ABANDONED.



**Mr. Robert Marcon,
3471 Sinnicks Avenue,
Niagara Falls, Ontario, Canada,
L2J 2G6**



Received this day from Robert V. Marcon
Communication-F (Statement of Response (Revision-
A)), totalling eight (8) pages for the trademark
application: L'OREAL PARIS, serial No.: 76/596,736,
Docket Number: Mark-21.

This Communication-F was sent by the
Applicant on 28 October 2009 via the U.S. Postal
Service as Certified First Class Mail, serial No. **7008
3230 0000 5106 2881**.



10-30-2009

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
3 **(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)**
4

5 **Opposition No.:** 91184456
6 **TRADEMARK:** L'OREAL PARIS
7 **Application Serial No.:** 76/596,736
8 **Applicant(s):** Robert Victor Marcon
9 **Opposer(s):** L'Oreal USA, Inc. and L'Oreal S.A.
10 **Opposer(s) Attorney:** Robert L. Sherman
11 **Number of Pages:** Eight (8)
12
13
14
15

16 **CERTIFICATE OF MAILING**

17 **Certification:** This correspondence is being deposited with the U.S. Postal Service as
18 Certified First Class Mail in an envelope addressed to, "U.S. Patent and
19 Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451,
20 Alexandria, VA, U.S.A., 22313-1451".

21 **Certified Mail Serial No.:** 7008 3230 0000 5106 2881

22 **Date of Deposit:** 28 October 2009

23
24 **Depositor's Signature:** Robert Marcon (Robert Marcon)
25
26
27

28 **Certification:** A copy of this correspondence is being deposited with the U.S. Postal
29 Service as Certified First Class Mail in an envelope addressed to, "Robert L.
30 Sherman, Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New
31 York, NY, U.S.A., 10022.

32 **Certified Mail Serial No.:** 7008 3230 0000 5106 2898

33 **Date of Deposit:** 28 October 2009

34 **Depositor's Signature:** Robert Marcon (Robert Marcon)
35

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant: Robert Victor Marcon
Mailing Address: Street: 3471 Sinnicks Avenue
City/Province: Niagara Falls, Ontario
Country: Canada
Zip Code: L2J 2G6
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IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"

COMMUNICATION - F
STATEMENT OF RESPONSE (SUPPLEMENTAL)

This is a response to the Office Letter mailed September 30, 2009 by the Trademark Trial and Appeal Board to the Applicant herein, namely, Robert Victor Marcon. Said Office Letter consists of a "Notice of Default" in that the Applicant has not answered the Opposer's amended notice of opposition by the August 27, 2009 due date. Consequently, the Applicant has thirty days from the mailing of said Office Letter to show cause why judgement by default should not be entered against the Applicant in accordance with Fed. R. Civ. P. 55(b).

Additionally, proceedings herein are otherwise suspended.

In defence of the Applicant the Applicant would like to state that this oversight was unintentional in that the Applicant, being unfamiliar with oppositional procedures, mistakenly believed that said answer to the Opposer's amended notice of opposition should be submitted during the Defendant's Pretrial Disclosures.

Since this assumption was incorrect, the Applicant will therefore provide the necessary response to the Opposer's amended notice of opposition in this communication. It is hoped that this will be acceptable to the Examiner.

To begin, the Applicant will respond to the principal new assertion made by the Opposer's Attorney in the amended notice of opposition abbreviated below.

L'OREAL'S MEMORANDUM IN SUPPORT OF MOTION

L'Oreal S.A. and L'Oreal USA, Inc. (collectively, "L'Oreal" or "Opposer") submits this memorandum in support of its motion to amend the Notice of Opposition in this proceeding against Robert Victor Marcon ("Applicant"), in order to add as a separate ground for its opposition Applicant's lack of bona fide intent to use its mark. Opposer's proposed amended pleading is attached to the declaration of Natalie G. Furman, dated June 29, 2009 ("Furman Decl."), submitted herewith.

I. PRELIMINARY STATEMENT

By this motion, L'Oreal seeks leave to amend its Notice of Opposition in order to assert an independent claim that Applicant lacked the requisite bona fide intent to use L'OREAL PARIS ("Applicant's Mark"), at the time he filed his application, thereby rendering the application invalid. During the course of discovery, L'Oreal sought to obtain information and documents regarding Applicant's bona fide intent to use L'OREAL PARIS in commerce. Applicant's responses and supplemental responses to Opposer's discovery requests, as well as subsequent communications, reveal that Applicant does not have any documentary evidence or any other objective evidence whatsoever to substantiate a bona fide intent to use Applicant's Mark. Furthermore, other applications admittedly owned by Applicant further support Opposer's belief that Applicant lacked the requisite bona fide intent to use. Opposer now has a basis for asserting a claim that Applicant lacked the statutorily required bona fide intent to use Applicant's Mark in commerce at the time of filing, and continuing to date, and that registration should be denied on that additional basis, and accordingly seeks to amend its Notice of Opposition.

Amendments to pleadings should be liberally granted whenever it is necessary for the furtherance of justice and would not be prejudicial to the rights of the other party. Opposer's motion for leave to amend should therefore be granted, because allowing the amendment would not prejudice Applicant in any way and because a lack of bona fide intent - if proven at trial - would mean that Applicant's application is invalid as a matter of law, such that that registration of Applicant's Mark must be refused. Justice requires granting L'Oreal's motion.

APPLICANT'S RESPONSE

The Applicant disagrees with the Opposer's view of the situation. That is, the Opposer maintains that any applicant applying for a trademark lacks the required "bona fide intent" mandated

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-F

135 by the law if they have not formed nor initiated the normal plans, preparations or other actions
136 associated with the commercial capitalization of the applied for trademark.

137 This basic premise seems to the Applicant to be both inconsistent and incongruous with the
138 fundamental idea of what proposed trademarks actually are. That is because it is the Applicant
139 understanding that all proposed trademark applications are a method of determining the legitimacy
140 of an applicant's claim to the applied for mark and wares prior to commercialization. In this way
141 resources that would have been expensed would not be if the mark were to be refused thereby
142 saving not only time and effort but also money. Moreover, any proposed trademark, if approved,
143 would by law be entitled to a period of approximately one year to implement the commercial
144 requirements under the law in order to effect registration on the principal registry.

145 Second, it is also the Applicant's understanding that there are no requirements on the
146 Applicant to show use of his mark until it has been approved. Therefore, the fact that the Applicant
147 has not begun to use his "L'OREAL PARIS" mark in association with his wares is not relevant.

148 Third, as a method of predetermining the rights conferrable upon a mark proposed
149 trademark applications seem reasonable not only in law but also in practice. For example, if the
150 Applicant had proceeded to conduct various market surveys or tests, secure both logistical and
151 distributional means, arranged commercial financing, initiated production of the wares applied for
152 or any other public act the Opposer would have surely tried to stop the Applicant in any one or all
153 of these undertakings. Therefore, would it not be prudent to first acquire those rights the Applicant
154 has sought to secure before aggressively venturing out into commerce. In this way, the expense,
155 time and effort that would have followed from the ensuing litigation could be simply avoided to the
156 benefit of both parties.

157 The Opposer has also claimed that the Applicant's lack of knowledge, skill, experience, and
158 production facilities as well as the Applicant's filing and non-commercialization of various other
159 trademark applications are proof of his lack of "bona fide intent". Consequently, the Applicant's
160 mark should be refused.

161 However, the Applicant contends that the Opposer's position is obviously skewed. That is
162 because there is nothing in the evidence submitted by either the Applicant or the Opposer which
163 suggests that the Applicant is not intending to use any of the applied for marks when they are
164 approved. Moreover, it is also the Applicant's understanding that the mere act of filing multiple
165 trademark applications is not prohibited by the law. As such, it does not by itself constitute
166 evidence that the Applicant lacks the requisite "bona fide intent" just because he has filed various
167 other trademark applications which have, as yet, not been commercialized.

168 Additionally, it must be remembered that the Applicant's stated intention to use his mark
169 does not necessarily mean that he will be manufacturing the applied for wares himself. They may
170 be manufactured by another party on behalf of the Applicant. Consequently, the fact that the
171 Applicant lacks any current manufacturing facilities is inconsequential to the outcome of this case.

172 In any event, the Applicant maintains that these other referenced marks belonging to the
173 Applicant do not provide any meaningful debate nor do they add any fitting examples regarding the
174 registrability of the Applicant's proposed mark "L'OREAL PARIS" and so should be disregarded.

175 That said, the Opposer has also claimed, as previously mentioned above, that the Applicant
176 is incapable of using the wares already approved in that he lacks the knowledge, skill, and
177 experience required to commercialize the applied for mark.

178 However, the Applicant asks by what measure, knowledge or clairvoyance does the
179 Opposer claim to know the ultimate outcome of any business enterprise. The Opposer's company
180 itself has commercially failed in various ventures examples of which can be viewed in the Trademark
181 Registry as abandoned marks.

182 It is also self-evident that the Opposer has failed to see the lessons of history. That is, some
183 underdogs have triumphed where large multinational corporations have failed. For example, Bill
184 Gates, a first year university dropout, helped found Microsoft a company which eventually became
185 larger than I.B.M. The reason being, I.B.M. mistakenly believed the market for small personal
186 computers was inconsequential. Mr. Dell, another first year university dropout, founded one of the
187 largest computer sales companies in the world beginning this enterprise in his university dorm
188 room. Federal Express was a company based upon a business model outlined in the founder's
189 university thesis. A thesis which, by the way, the presiding professors ruled a model without hope
190 of success. There are also many other historical examples from which to draw upon but it is
191 believed sufficient to say that the outcome of any business venture is not always readily apparent.

192 Thus, it appears to the Applicant that what the Opposer is or must be really trying to say is
193 that any trademark applicant should first be graded on their business skills, talent, and resources in
194 order to ascertain whether or not they will succeed. If they fail to measure up to certain
195 prerequisites or other preestablished criteria they should then be denied trademark registration
196 without giving them the opportunity to even try. However, the Applicant believes that this premise
197 is in direct contrast to what trademark law truly is and especially so as it regards proposed marks.

198 Moreover, the Opposer has also insinuated that the Applicant is a "trademark trafficker".
199 That is, the Opposer feels that the Applicant should not be able to apply for the trademarks of
200 others that it believes are well known or famous. That the Applicant is breaking the fundamental

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-F

spirit of trademark law when he has pursued this course of action. In other words, the Opposer believes that the Applicant has abused the Trademarks Register by applying to register rights in association with a number of well-known and famous trademarks and to trade on their goodwill. That the Applicant's bad faith activities are obstructing the timely advancement of routinely filed applications which the Opposer files from time to time and so poses a threat of dilution and depreciation of the Opposer's marks. Thus, the Applicant should be unequivocally refused registration.

However, what the Opposer fails to understand is that in so alleging said claim and in so demanding said refusal it itself becomes an instrument of abuse. That is because the Applicant believes that care must be taken not to create a zone of exclusivity and protection that overshoots the purpose of trademark law. On the one hand, well-known mark owners say that people should not reap where they have not sown, that bad faith should be punished, that people who sidle up to their well-known marks are guilty of dishonest commercial practice. These vituperations lead nowhere. One might as well say that the well-known mark owner is reaping where it has not sown when it stops a trader in a geographic or market field remote from the owner's field from using the same or a similar mark uncompetitively.

In other words, each trademark application must be weighed on its own merits and not on irrational allegations. The facts in any case, be it civil or criminal, are what must be impartially assessed in order to ascertain the validity of the evidence submitted and the debates put forth. When the Opposer accuses the Applicant of "cyber squatting" the Applicant asks how has the Opposer been harmed by these other filings? The fact that the Applicant has applied for multiple registrations is beside the fundamental focus of these opposition proceedings, namely, whether or not the Applicant's mark "L'OREAL PARIS" is or is not registrable.

The Opposer, therefore, by alleging the Applicant a "cyber squatter" is simply making itself out to be a "Monopolist" of the most egregious kind. That is because there is no regulation, stipulation or law that prevents the Applicant or anyone else from filing multiple applications. If any mark submitted is found to be, during due process, valid, just, and fair in that said mark does not improperly infringe on the marks of another then how has that other party been harmed?. The answer is -- they have not.

Since the Applicant has therefore progressed at all times in a manner that is logical and proper filing all necessary forms as mandated and observing the requirements of the law as legislated it perplexes the Applicant why the Opposer would claim that the Applicant has not adhered to the provisions of trademarks law. What, in reality, could the Applicant have done differently that would

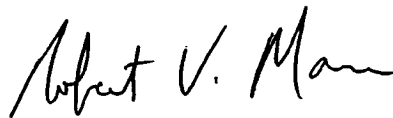
Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-F

have satisfied the Opposer? The Applicant believes nothing.

It therefore seems reasonable to consider "bona fide intent" an inherent and natural intention of any proposed trademark application. Second, the Applicant as well as anyone else should be permitted to see if their respective marks are allowed first before providing proof of commercialization. Third, unrelated trademark applications are not against the law nor do they provide any meaningful debate regarding the registrability of the Applicant's mark "L'OREAL PARIS" which is the central focus of these opposition proceedings. Fourth, skill, experience, talent, and knowledge are all subjective in nature and so would be an ill advised gauge to use in the determination of a trademark application's outcome. Fifth, production facilities can always be procured via subcontracting production to a third party, renting or leasing the facilities or equipment as required, and even purchasing the facilities and equipment outright once trademark approval has been granted.

In conclusion, the Applicant therefore believes the Opposer's claims are without merit and so should be rightfully dismissed.

Respectfully submitted,



Robert V. Marcon,
Applicant Pro Se
28 October 2009

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
3 **(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)**
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5 **Opposition No.:** 91184456
6 **TRADEMARK:** L'OREAL PARIS
7 **Application Serial No.:** 76/596,736
8 **Applicant(s):** Robert Victor Marcon
9 **Opposer(s):** L'Oreal USA, Inc. and L'Oreal S.A.
10 **Opposer(s) Attorney:** Robert L. Sherman
11 **Number of Pages:** Fifteen (15)
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21 Alexandria, VA, U.S.A., 22313-1451".
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23 **Certified Mail Serial No.:** 7008 1830 0002 1395 0568
24 **Date of Deposit:** 1 December 2009

25
26 **Depositor's Signature:** Robert Marcon (Robert Marcon)
27
28
29
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31
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33
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35